OIPE
NOV 0 7 2005
IAP82
PATENT & TRADEMARK OFFICE

1374.43140X00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	F. NAKAYAMA et al
Application No.:	10/670,258
Filed:	September 26, 2003
For:	SEMICONDUCTOR DEVICE INCLUDING MULTIPLE WIRING LAYES AND CIRCUITS OPERATING IN DIFFERENT FREQUENCY BAND
Art Unit:	2891
Examiner:	B. SMITH

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

November 7, 2005
(Monday)

Sir:

In response to the Election of Species Requirement dated October 5, 2005, Applicants respectfully traverse this election requirement and request consideration for the following reasons.

The Election of Species Requirement is directed to claims 28-43 being divided into species I, and active device, and species II a passive device. With regard to this, it is noted that all of claims 28-43 have been both examined and allowed in the Office Action dated April 19, 2005. Normally, as indicated in MPEP s18.01 "election becomes fixed when the claims in an application received an action on their merits by the Office." Although, of course, an election requirement can be made at any time during the prosecution, MPEP §811 indicate:

> "This means the Examiner should make a proper requirement as early as possible in the prosecution, in the first

> action if possible, otherwise, as soon as the need for a proper requirement develops."

It is respectfully submitted that, in the present instance, since the Examiner has already gone to the effort of searching all of the claims, and, accordingly, both the active and passive species, and has allowed all of these claims based upon the examination, there should be no need for a restriction requirement at the present time. Further, it is noted that MPEP §803 specifically states:

> "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions."

Obviously, in the present instance, since the search and examination of the entire application has already been made, there should be no serious burden in continuing prosecution of both species in the present application.

On the other hand, if it is required for the Applicant to elect a species and file a divisional application, a serious burden will be placed on both the USPTO and the Applicant. More specifically, the USPTO will have to process another application, thereby utilizing manpower, time and resources on claims that have already been indicated as being allowable. Of course, from the Applicants perspective, filing a second application on claims that have already been searched, examined and indicated as allowed will lead to much greater expense in terms of additional filing fees, issue fees, maintenance fees, etc., as well as loss of time in processing of the divisional application (costing Applicants patent term regarding their invention) and, of course, additional Attorneys fees. Therefore, it is respectfully requested that the

Examiner reconsider his position in this manner and proceed to allow all of claims 28-43, as originally indicated in the April 19, 2005 Office Action.

Notwithstanding the above traversal, in order to be fully responsive to the election requirement, Applicants hereby elect the species I directed to an active device, noting that claims 28-32 and 38-43 can be read on this elected species.

To the extent necessary, Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Antonelli, Terry, Stout & Kraus, LLP Deposit Account No. 01-2135 (Docket No. 501.43140X00), and please credit any excess fees to such deposit account.

Respectfully submitted,
ANTONELLI, TERRY, STOUT & KRAUS, LLP

By _____
Gregory E. Montone
Reg. No. 28,141

GEM/kmh/dks
N:\1374\43140X00\RES\CJ663.DOC

1300 North Seventeenth Street, Suite 1800
Arlington, Virginia 22209
Telephone: (703) 312-6600
Facsimile: (703) 312-6666